

Doc Code: AP.PRE.REQ

PTO/SB/33 (01-09)

Approved for use through 02/28/2009. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

007287.00035

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

09/854334

Filed

May 11, 2001

First Named Inventor

Dan Kikinis

Art Unit

2421

Examiner

Nguyen BA, Hoang Vu A

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Stephanie L. Knapp/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Stephanie L. Knapp

Typed or printed name

☒ attorney or agent of record.
Registration number 62473

(202) 824-3000

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

April 22, 2009

Date

Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	Atty. Docket No.:	007287.00035
Dan Kikinis <i>et al.</i>		
Serial No.: 09/854,334	Group Art Unit:	2421
Filed: May 11, 2001	Examiner:	Nguyen Ba, Hoang Vu A
For: UNIVERSAL PROGRAMMING SYSTEM AND METHOD FOR EPG WITH LOCALIZED INTERACTIVE CONTENT	Confirmation No.:	7799

Pre-Appeal Brief Request For Review

U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

Remarks

Having received and reviewed the Final Office Action dated January 22, 2009, Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The pending rejections fail to address all the claim limitations, and exhibit clear factual and legal errors with respect to the cited references. The specific error relied upon in this Pre-Appeal Brief Request for Review includes the following:

- The Office made clear error in relying on U.S. Patent No. 6,662,177 to Martino *et al.* ("Martino") in its rejection of claims 1-3, 5, 8, 9, 11, 12, 14-16, 20, 22-25, 27, and 35 as discussed in Applicants' Response to the Non-final Rejection dated

August 1, 2009, at pp. 7-8. Independent claims 12 and 23 recite, among other features, “selecting a first object configured to define a layout of an interactive electronic programming guide (EPG) displaying content programming information; selecting a second object including a localized interactive component for display in the interactive EPG; storing in memory a third object including information associated with current programming events; and generating the interactive EPG by combining the received first object, the second object, and the third object.” The Office Action alleges that Martino discloses all of the features of independent claims 12 and 23. Applicants respectfully disagree. The Office Action asserts that the software module of Martino that presents three-dimensional visual graphics constitutes a first object as recited in the claims, the software module that displays the search world and/or the profile world constitutes a second object as recited in the claims, and the software module that displays the overview world, which is the result of the search, constitutes a third object, as recited in the claims. *See* Final Office Action, page 3. Rather, Martino discloses a user interface that generates three “environments” or “worlds”. *See Martino*, col. 2, lines 19-29. In particular, a “search world”, a “profiling world”, and an “overview world” are described. *See Martino*, col. 2, lines 21-22. In the search world of Martino, a user enters, saves, and edits filtering and sorting criteria, such as the time of day, day of week, or genre. *See Martino* col. 2, lines 23-25. In the profiling world of Martino, a user generates and modifies user profiles. *See Martino* col. 2, lines 25-27. In the overview world, the user views and selects among the results of the search, which is a result of the sorting, filtering, and profiling information. *See Martino* col. 2, lines 27-29. However, the overview world of Martino does not constitute a third object as recited in the claims. Rather, the overview world of Martino provides a way of presenting information, and specifically presenting the *results of the search world*, not “a third object including a localized interactive component for display in the interactive EPG” as recited. (Emphasis added.)

- Additionally, as is evident from the description and figures of Martino, the overview world or, more properly, the overview “environment” or interface, is completely

distinct and unrelated to generation of an EPG in Martino. *See Martino*, col. 2, lines 19-29. In fact, the overview world of Martino is created as a result of the second world and thus, can not be combined with the second world to generate an EPG. *See Martino*, col. 2, lines 27-29. Accordingly, Martino fails to teach or suggest the features of claims 12 and 23 and, thus, claims 12 and 23 are patentably distinct from Martino.

- Claims 12 and 23 further recite, “a second object including a localized interactive component for display in the interactive EPG.” Martino merely discloses an MbTV system that learns its viewers’ television watching tastes by monitoring the way in which viewers handle program suggestions or recorded content in order to build a profile of the viewers’ tastes and recommend or record programs. *See Martino* col. 3, ll. 16-27. Thus, the MbTV disclosure in Martino fails to teach or suggest a localized interactive component *for display in the interactive EPG*, as recited in claim 12.
- Accordingly, for at least these reasons, claims 12 and 23 are allowable over Martino. Claims 14-16, 20, and 22 24, 25, and 27 depend from claims 12 and 23 and are allowable over Martino for at least the same reasons as their respective base claims.
- The Office made clear error in relying on Martino in its rejection of claim 1. Claim 1 recites, among other features a processor configured to generate the interactive EPG by combining the first object, the second object and the third object, wherein a layout of the interactive EPG is defined by the first object. As discussed above with respect to claims 12 and 23, Martino fails to teach or suggest generating an interactive EPG by combining the first object, the second object, and the third object, as recited in claim 1. Accordingly, claim 1 is allowable over Martino for at least this reason. Claims 2, 3, 5, 8, 9, 11, and 35 depend from claim 1 and are allowable for at least the same reasons as claim 1.
- The Office made clear error in relying on Martino in view of U.S. Patent No. 6,754,906 to Finseth et al. (“Finseth”) in its rejection of claims 7, 10, 18, 19, 21, and

28-34. Claims 7, 10, 18, 19, 21, 22, and 28-depend from claims 1, 12 and 23 and are allowable for at least the same reasons as their base claims and further in view of the additional novel and non-obvious features recited therein. The addition of Finseth fails to cure the deficiencies of Martino. Accordingly, claims 7, 10, 18, 19, 21, 22, and 28-24 are allowable over the cited combination of references.

While Applicants believe that the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. Applicants further reserve the right to address the rejections of any other claims not identified above on appeal should the appeal of this case proceed after the Office's consideration of this paper.

Conclusion

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3130.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: April 22, 2009

By: /Stephanie L. Knapp/
Stephanie L. Knapp, Reg. No. 62,473
1100 13th Street, N.W.
Washington, D.C. 20005
Tel: (202) 824-3000
Fax: (202) 824-3001